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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,538	12/28/2001	Neal B. Gittleman		1429

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EXAMINER

O CONNOR, CARY E

ART UNIT	PAPER NUMBER
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.3732

DATE MAILED: 04/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,538

Applicant(s)

GITTLEMAN

Examiner

Cary E. O'Connor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,8,10 and 12-16 is/are rejected.
- 7) ☒ Claim(s) 3,5-7,9 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 10, line 1, it is unclear if "a hollow expansion tube" refers to the hollow expansion tube set forth in claim 1 or is an additional expansion tube.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 8 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hobo (6,227,860). Hobo shows a dental implant 10 comprising an upper socket 14, a hollow expansion tube with a wall having alternating ribs 17 and open spaces, and a lower retaining nut 20. The tube is compressible along a major axis by tightening a retaining compression screw 30 through the socket, tube and nut so that the ribs expand outward upon tightening of the screw. As to claim 2, note the thinner portions

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19a of the ribs. As to claim 4, the thinner portion 19a can be considered notches. As to claim 8, the ribs have edges that are parallel to the axis of the tube (see Fig. 1). As to claim 13, note the slot in the head of the screw. Regarding the recitation that the slot can mate with a tongue in the underside of an abutment, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hobo (6,227,860) in view of Hinds (6,039,568). The tube of Hobo does not have a truncated conical shape. The implant of Hinds comprises a tube having a truncated conical shape. It would have been obvious to one of ordinary skill in the art at the time the

invention was made to form the tube of Hobe in the shape of a truncated cone, in view of Hinds, in order to provide further stability of the implant in the bone.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hobo (6,227,860) in view of Levisman (6,350,126). Hobo does not disclose a bone growth promoting coating on portions of the implant. Levisman teaches coating portions of a dental implant with a bone promoting material (column 4, lines 21-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the tube of Hobo with a bone promoting coating, as taught by Levisman, in order to promote bone growth around the tube to provide a more secure fit in the bone.

Claims 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobo (6,227,860) in view of Schroder (DE 197 05 571). The screw of Hobo does not include a tapered, hexagonal head mating in a tapered hexagonal recess in the underside of an abutment. Schroder shows an expandable dental implant having an expansion screw 33 including a tapered, hexagonal head (see Fig. 12) for mating in a tapered hexagonal recess 8g in the underside of an abutment (see Fig. 15c). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the expansion screw of Hobo with a tapered, hexagonal head, in view of Schroder, in order to provide the implant with an anti-rotational connection between the implant and the abutment.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hobo (6,227,860) in view of Sutter et al (5,667,384). Hobo does not include perforations through the ribs. Sutter employs perforations 4p in the tubular body of the implant to

promote interlocking bone growth. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the ribs of Hobo with perforations, as taught by Sutter, in order to provide interlocking bone growth into the tube.

Allowable Subject Matter

Claims 3, 5-7, 9 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 5, 8, 15, 16 and 7 (Fig. 1), 8 (Fig. 9), 69 and 70 (Fig. 10). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

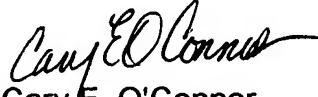
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th, 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-0858. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-308-2708 for regular communications and 703-308-2708 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.


Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
April 22, 2003